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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,531	06/19/2001	Brian McConnell	302674US91	2612
22850 7590 01/23/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER BHATIA, AJAY M	
			ART UNIT 2145	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/884,531	Applicant(s) MCCONNELL ET AL.	
	Examiner AJAY BHATIA	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Applicant argues examiner's 112 rejection. Examiner has reviewed the cited portion of application's specification, but it does address all of the deficiencies. Applicant requested further clarification of the 112, which examiner has provided. Additionally the specification does not provided sufficient support to allow implementation therefore requiring undue experimentation. The 112 rejection is maintained.

Applicant also argues that applicant amendment of "at the email server" differs from the present prior art, examiner disagrees. Schemers in Col. 2 line 65 to Col. 3 line 5, discloses the messaging system comprises the web server and telephony server. Applicant's amendment of at the email server fails to distinguish from the present invention, since the telephony server communicates with the telephone and authentication occurs in the web server which is the email server (Col. 4 lines 35-65, web server identification information). The present rejection is maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Based upon arguments presented by applicant's representative it appears the

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disclosed features of the invention are not commonly well-known and applicant is using non-conventional systems, therefore it would appear that present specification lacks sufficient detail to allow one of skill in the art to implement the present invention without undue experimentation.

Specifically the claims state “receiving a call in an email server,” the specification fails to disclose how the email server is able to receive a call. Additionally the claims specify “recording the voice message at the email server” which is not supported, because it relies upon the call which is not supported by the specification. Therefore the specification requires undue experimentation since no disclosure is provided.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6, 7, 11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Schemers et al. (US Patent 6,751,453).

For claim 6, Schemers teaches, a method for enabling a portable electronic device to communicate with an enterprise terminal comprising:

receiving a call in an email server of the enterprise from the portable electronic device; (Schemers, Col. 5 line 63 to Col. 6 line 23. telephone server, Col. 2 line 65 to Col. 3 line 5, messaging system, web server and telephony server)

determining if the portable electronic device is registered in the email server of the enterprise; (Schemers, Col. 5 line 6 to Col. 6 line 30, telephone number)

obtaining, at the email server, a pre-assigned message identifier from the portable electronic device, the message identifier assigned to an e-mail message received by the electronic device from the email server, the identifier corresponding to an author of the received email; (Schemers, paragraph 3 reply by voice, Col. 6 lines 30-50, Col. 2 line 65 to Col. 3 line 5, messaging system, web server and telephony server, Col. 4 lines 35-65, web server identification information)

authenticating the message identifier at the email server of the enterprise;
(Schemers, Col. 3 lines 57-67, user id password)

requesting a recording of a voice message from the user of the portable electronic device as a reply to the email message; (Schemers, Col. 6 lines 50-61, email)

recording the voice message at the email server; (Schemers, Col. 6 lines 50-61, voice object)

and transmitting the voice message to the enterprise terminal. (Schemers, Col. 6 lines 50-61, email)

For claim 7, Schemers teaches, the method for enabling a portable electronic device to communicate with an enterprise terminal according to claim 6, further comprising:

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converting the recorded voice message into a format adapted for attachment to an electronic message. (Schemers, Col. 7 lines 1-15, wav)

For claim 11, Schemers teaches, the method for enabling a portable electronic device to communicate with a terminal according to claim 6, further identifying a user of the portable electronic device by using a Caller ID service. (Schemers, Col. 5 line 63 to Col. 6 line 22, telephone number)

For claim 13, Schemers teaches, the method for enabling a portable electronic device to communicate with an enterprise terminal according to claim 6, wherein pre-assigned message identifier allows transmission of the voice message to the enterprise terminal. (Schemers,), paragraph 3 reply by voice, Col. 6 lines 30-50)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schemers et al. (US Patent 6,751,453) in view of Von Meister et al. (U.S. Patent 5,199,062).

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Schemers fails to clearly disclose, playing an error message an terminating communication with the e-mail server if the device is not registered in the email server.

Von Meister teaches, the method for enabling a portable electronic device to communicate with an enterprise terminal according to claim 6, further comprising:

playing an error message an terminating communication with the e-mail server if the device is not registered in the email server. (Von Meister, Col. 11 lines 50-67)

Von Meister and Schemers are both in the filed of hand set voice mail systems

Von Meister et al. and Schemers are compatible to add the method of an error message

It would have been obvious to on of ordinary skill in the art at the time of the invention was made to combine Von Meister method of playing an error message and Schemers because answering service and message machine does not always work well. (Von Meister, Col. 1 lines 50-55)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schemers et al. (US Patent 6,751,453) in view of Ertz et al. (U.S. Patent 5,003,577).

For claim 9, Schemers fails to clearly disclose:

determining if the recorded message is acceptable;

and recording the message again if the previously recorded message is not acceptable.

Ertz teaches, the method for enabling a portable electronic device to communicate with an enterprise terminal by voice according to claim 6, further comprising:

determining if the recorded message is acceptable; (Ertz, Col. 17 lines 17-65, delete, record new)

and recording the message again if the previously recorded message is not acceptable. (Ertz, Col. 17 lines 17-65, delete, record, new)

both Ertz and Schemers are in the field of voice mail systems

the system of Ertz and Schemers are compatible to add Ertz system of allowing the record to record the voice mail message

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to add the system of recording a voice message of Ertz to that of

Schemers, because it allows for the use of a myriad of user interfaces. (Ertz, Col. 2 lines 4-9, interface)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schemers in view of Google groups April, 18-19, 1999.

For claim 10, Schemers teaches, a method for enabling a portable electronic device to communicate with an enterprise terminal, comprising the step of:

receiving a call in an email server of the enterprise from the portable electronic device; (Schemers, Col. 5 line 63 to Col. 6 line 23. telephone server)

determining if the portable electronic device is register in the email server; (Schemers, Col. 5 line 6 to Col. 6 line 30, telephone number)

obtaining, at the email server, a pre-assigned message identifier from the user portable electronic device, the message identifier assigned to an email message received by the portable electronic device from the email server, the identifier corresponding to an author of the received email; (Schemers, paragraph 3 reply by

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voice, Col. 6 lines 30-50, Col. 2 line 65 to Col. 3 line 5, messaging system, web server and telephony server, Col. 4 lines 35-65, web server identification information)

authenticating the message identifier at the email server of the enterprises;
(Schemers, paragraph 3 reply by voice, Col. 6 lines 30-50)

requesting a recording of a voice message from the user of the portable electronic device as a reply to the email message; (Schemers, paragraph 3 reply by voice, Col. 6 lines 30-50)

recording the voice message at the email server; (Schemers, Col. 6 lines 50-61, voice object, Col. 2 line 65 to Col. 3 line 5, messaging system, web server and telephony server)

and transmitting the converted voice message to the user of the enterprise terminal. (Schemers, Col. 6 lines 50-61, email)

Schemers fails to clearly disclose, converting the recorded voice message into MP-3 format;

Google Groups teaches, converting the recorded voice message into MP-3 format;
(Goggle groups page 1)

Schemers and Google groups are both in the field of audio recording

Schemers and Google groups is compatible, since Google groups converts Schemers's

*.WAV file into MP3

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to convert Schemers's WAV file into Google groups MP3 because to make the audio more compact.

For claim 14, Schemers-GG teaches, the method for enabling a portable electronic device to communicate with an enterprise terminal by according to claim 10, further comprising identifying a user of the device by using a Caller ID service. (Schemers, Col. 5 line 6 to Col. 6 line 30, telephone number)

For claim 16, Schemers-GG teaches, the method for enabling a portable electronic device to communicate with an enterprise terminal according to claim 10, wherein the pre-assigned message identifier allows transmission of the voice message to the terminal. (Schemers, paragraph 3 reply by voice, Col. 6 lines 30-50)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schemers in view of Saylor et al. (U.S. Patent 6,501,832).

For claim 12, Schemers teaches, authenticating the PIN to determine whether the PIN is valid. (Schemers, Col. 3 lines 56-67, password)

Schemers fails to clearly disclose, prompting, if a Caller ID service is not operating, a user of the portable electronic device to enter a personal identification number ("PIN"); (Schemers,)

For claim 12, Schemers teaches, the method for enabling a portable electronic device to communicate with an enterprise according to claim 6, further comprising;

prompting, if a Caller ID service is not operating, a user of the portable electronic device to enter a personal identification number ("PIN"); (Saylor, Col. 7 line 55 to Col. 8 line 14, caller ID, codes, password)

and authenticating the PIN to determine whether the PIN is valid. (Saylor, Col. 7 line 55 to Col. 8 line 14, caller ID, codes, password)

Saylor and Schemers are both in the field of voice server systems

Saylor and Schemers are compatible, since Schemers check for user identity using Caller ID

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to add Saylor method of authenticating a PIN when caller ID is not available to Schemers, because it allows for a more secure system. (Saylor, Col. 7 line 55 to Col. 8 line 14)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schemers in view of Schemers in view of Google groups April, 18-19, 1999 in further view of Saylor et al. (U.S. Patent 6,501,832).

For claim 15, Schemers-GG teaches, authenticating the PIN to determine whether the PIN is valid. (Schemers, Col. 3 lines 56-67, password)

Schemers-GG fails to teach, further comprising' prompting, if a Caller ID service is not operating, a user of the portable electronic device to enter a PIN;

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For claim 15, Saylor teaches, the method for enabling a portable electronic device to communicate with an enterprise terminal according to claim 10, further comprising' prompting, if a Caller ID service is not operating, a user of the portable electronic device to enter a PIN; (Saylor, Col. 7 line 55 to Col. 8 line 14, caller ID, codes, password)

and authenticating the PIN to determine whether the PIN is valid. (Saylor, Col. 7 line 55 to Col. 8 line 14, caller ID, codes, password)

Saylor and Schemers are both in the field of voice server systems

Saylor and Schemers are compatible, since Schemers check for user identity using Caller ID

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to add Saylor method of authenticating a PIN when caller ID is not available to Schemers, because it allows for a more secure system. (Saylor, Col. 7 line 55 to Col. 8 line 14)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached Notice of references cited (if appropriate).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AJAY BHATIA whose telephone number is (571)272-3906. The examiner can normally be reached on M-H 9:00-3:30, Also please fax interview requests to 571-273-3906.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AB

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145